

1 H. MICHAEL BRUCKER LAW
CORPORATION
2 H. MICHAEL BRUCKER (#36297)
5855 DOYLE STREET, SUITE 110
3 EMERYVILLE, CA 94608
Telephone: (510) 654-6200
4 Facsimile: (510) 654-6166
E-Mail: michael@hmblawoffice.com

5 STEVEN M. KIPPERMAN LAW
CORPORATION
6 STEVEN M. KIPPERMAN (#40895)
57 Post Street, Suite 604
7 San Francisco, CA 94104
Telephone: (415) 397-8600
8 Facsimile: (415) 397-0792
9 E-Mail: kipperman@aol.com

10 Counsel for Defendant Smith News Company,
Inc.

11 UNITED STATES DISTRICT COURT
12 CENTRAL DISTRICT OF CALIFORNIA

13 KAROL WESTERN CORP.,

14 Plaintiff,

15 vs.

16 SMITH NEWS COMPANY, INC.
17 dba SMITH NOVELTY COMPANY

18 Defendant.
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Case No. CV12- 7695 BRO (VBKx)

Defendant's Reply to Plaintiff's Opposition
to Defendant's Motion in Limine No. 1

Hearing: March 3, 2014

Time: 1:30 PM

Place: Courtroom 14

Complaint Filed: Sept. 7, 2012

Trial Date: March 25, 2014

1 Defendant's Motion in Limine No. 1 seeks to limit the testimony of
2 Plaintiff's expert Mr. Sedlik.

3 Plaintiff's Opposition to Defendant's Motion is based on an incorrect reading
4 of Plaintiff's motion, the resort to case law that is inapposite, outdated, and not
5 controlling in the Ninth Circuit, and an attempt to apply fact-specific application of
6 the law to non-analogous facts.

7 **A CORRECT STATEMENT OF DEFENDANT'S MOTION**

8 Defendant's motion, rather than seeking to keep Plaintiff's expert, Mr.
9 Sedlik, from giving any testimony, as Plaintiff has reframed Defendant's motion,
10 seeks only to prevent Plaintiff's expert from opining on any legal conclusions, such
11 as "substantial similarity" and "striking similarity".

12 **THE APPLICABLE LAW**

13 Plaintiff suggests that, rather than follow those myriad of cases since *Roth*
14 and *McCulloch* that require dissection, filtration and exclusion of unprotectable and
15 non-copyrightable elements, particularly in cases of pictorial, graphic and sculptural
16 works, the court stick with *Roth* and *McCulloch*, ignore more recent controlling
17 Ninth Circuit cases, and instead look to cases from the Southern District of New
18 York.

19 Plaintiff attempts to ridicule the Ninth Circuit's filtration and exclusion test
20 by arguing that, if applied to literary works, all words would have to be excluded
21 illustrates how lacking Plaintiff is for a rational argument. In addition to failing to
22 find any authority for such an absurd application of Ninth Circuit jurisprudence, the
23 argument simply does not scan. In literary works, it is not individual letters or
24 words that constitute a work, but rather theme, plot, characters, etc., that are created
25 by the words and those are the elements that are tested when analyzing for
26 substantial similarity. To those elements, the same rigor of dissection, filtration and
27 exclusion apply.
28

1 As regards works other than compilations, there could be no statement more
 2 opposed to the controlling law in the Ninth Circuit for at least the past 20 years than
 3 the one relied on by Plaintiff, to wit: “. . . the original combination, selection, and
 4 arrangement of individual unprotected design features in a work of visual art . . . is
 5 itself a copyright protected element.” [emphasis added]

6 What Plaintiff describes is a “compilation”.¹ Plaintiff did not register its
 7 work as a compilation, and even its failed attempt to expand its copyright
 8 registration did not identify its work as a compilation. It is far too late in the day of
 9 this case for Plaintiff to now claim its copyright is for a compilation (which it
 10 sometimes refers to as a “combination”).

11 The Compendium II of Copyright Office Practice, §307.01 states:

12 “A compilation is registrable if its selection, coordination, or arrangement as
 13 a whole constitutes an original work of authorship. The greater the amount of
 14 material from which to select, coordinate, or order, the more likely it is that
 15 the compilation will be registrable. Where the compilation lacks a certain
 16 minimum amount of original authorship, registration will be refused. Any
 17 compilation consisting of less than four selections is considered to lack the
 18 requisite original authorship.”

19 In its Opposition to Defendant’s Motion in Limine No. 3, Plaintiff concedes
 20 that: “. . . the Shanghai Diamond design passes the separability test in that it, at
 21 least, can be conceptually² separated from the useful article (flask or tumbler) on
 22 which it is applied.” (Emphasis added.) Unless the restrictions of 17 U.S.C. §§ 101
 23 and 102(a)(5) regarding useful articles are to be ignored, Plaintiff is only entitled to
 24 a separate copyright on that Shanghai Diamond design that it now admits is that
 25 which is separable from a useful article. The Shanghai Diamond design is, of
 course, Plaintiff’s expression of a die cut image of The Sign.

26 ¹ 17 U.S.C. § 101 (“A ‘compilation’ is a work formed by the collection and assembling of
 27 preexisting materials or of data that are selected, coordinated, or arranged in such a way that the
 resulting work as a whole constitutes an original work of authorship. The term “compilation”
 includes collective works.)

28 ² The Shanghai Diamond design is not just conceptually separable, but physically separable.
 Def’s Reply to Plf’s Opp. to Def’s 2 Case No. CV12-7695 BRO (VBK)
 Motion in Limine No. 1

1 Plaintiff 's "work" - a die cut image of the Las Vegas Sign ("the Sign") - is
 2 comprised of four elements, all copied from and arranged according to The Sign
 3 itself and thus do not constitute an original "selection, and arrangement of
 4 individual elements". If Plaintiff wants to now claim that its work is a compilation,
 5 in doing so, by its own definition, it necessarily concedes that all of the elements of
 6 its work are unprotected.

7 Even if the fact that only the die cut image of The Sign separate and
 8 independent of the flask is copyrightable is ignored contrary to the unequivocal
 9 statutory mandate,³ the flask is not a protectable compilation any more than was the
 10 jelly fish sculpture in *Satava v. Lowry*, 323 F. 3d 805 (9th Cir 2003):

11 "Our case law suggests, and we hold today, that a combination of
 12 unprotectable elements is eligible for copyright protection only if those
 13 elements are numerous enough and their selection and arrangement original
 14 enough that their combination constitutes an original work of authorship. The
 15 combination of unprotectable elements in *Satava's* sculpture falls short of this
 16 standard. The selection of the clear glass [flask] , oblong shroud [die cut
 17 process], bright colors [glitter paper], proportion, vertical orientation, and
 18 stereotyped jellyfish [the Sign] form, considered together, lacks the quantum
 19 of originality needed to merit copyright protection."

20 "But it is not true that *any* combination of unprotectable elements
 21 automatically qualifies for copyright protection. Our case law suggests, and
 22 we hold today, that a combination of unprotectable elements is eligible for
 23 copyright protection only if those elements are numerous enough and their
 24 selection and arrangement original enough that their combination constitutes
 25 an original work of authorship. See *Metcalf*, 294 F.3d at 1074; *Apple*
 26 *Computer, Inc.*, 35 F.3d at 1446. See also *Feist*, 499 U.S. at 358, 111 S.Ct.
 27 1282 ("[T]he principal focus should be on whether the selection,
 28 coordination, and arrangement are sufficiently original to merit protection.").

24 See also *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F. 2d 197 (9th Cir.
 25 1989).

27 ³ 17 U.S.C. §101 (" . . . the design of a useful article, . . . shall be considered a pictorial, graphic, or
 28 sculptural work only if, and only to the extent that, such design incorporates pictorial, graphic, or
 sculptural features that can be identified separately from, and are capable of existing
 independently of, the utilitarian aspects of the article."

1 The use of flasks as souvenirs is common. The use of the die cut process for
 2 souvenirs has been done. The use of an image of The Sign on souvenirs for Las
 3 Vegas is so common as to be *de rigor*. The use of glitter (bling) on Las Vegas
 4 souvenirs is common.

5 Plaintiff's rebuttal to the line of cases cited by Defendant that deal with
 6 pictorial, graphic and sculptural works, such as that at issue here, are, again, non-
 7 analogous music cases and cases outside of the Ninth Circuit. Even *Swirsky*
 8 acknowledges that "it is essential to distinguish between the protected and
 9 unprotected material in plaintiff's work."⁴ *McCulloch* makes no such distinction.

10 Even *Cavalier v. Random House, Inc.*, 297 F.3d 815, 826 (9th Cir. 2002),
 11 cited by Plaintiff, supports Defendant's assertion that *Roth* and *McCulloch* no
 12 longer state good law since they do not require that unprotected elements be
 13 identified and filtered out:

14 A court "must take care to inquire only whether 'the *protectable*
 15 *elements, standing alone*, are substantially similar.' " *Williams v. Crichton*,
 16 84 F.3d 581, 588 (2d Cir.1996) (emphasis in original) (citation omitted);
 17 *accord Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442–43 (9th
 18 Cir.1994). Therefore, when applying the extrinsic test, a court must filter out
 19 and disregard the non-protectable elements in making its substantial
 20 similarity determination. *823 *See Shaw*, 919 F.2d at 1361 (applying the
 21 extrinsic test to determine "whether there is substantial similarity between the
 22 *protected* expression of ideas in two literary works") (emphasis added);
Berkic v. Crichton, 761 F.2d 1289, 1293–94 (9th Cir.1985) (rejecting
 consideration of general ideas as well as scenes-a-faire in determining
 substantial similarity under the extrinsic test).

23 "This does not mean that at the end of the day, when the works are
 24 considered under the intrinsic test, they should not be compared as a whole.
 25 Nor does it mean that infringement cannot be based on original selection and
 26 arrangement of unprotected elements. However, the unprotectable elements
have to be identified, or filtered, before the works can be considered as a
whole." (emphasis added)

28 ⁴ Which Plaintiff's expert did not do and admitted he could not do.

1 Regarding Mr. Sedlik's deposition transcript, Plaintiff is apparently
2 mistaken. Attached hereto are letters received by Defendant's counsel on or about
3 January 4, 2013 and November 16, 2013 from the court reporter service notifying
4 him that Mr. Sedlik was notified that his transcript was available for review and he
5 did not review it during the time allowed. The letters indicate that they were sent to
6 Plaintiff's counsel as well.

7 Plaintiff has offered nothing that should persuade the court to allow
8 Plaintiff's expert to give legal opinions at trial. By his own admission, he is not a
9 legal expert and, by his own admission, he does not know what the legal
10 significance is, or the test for, "substantial similarity" or "striking similarity" as it is
11 applied in copyright cases.

12 Defendant's motion should be granted.

13 Dated: February 14, 2014

14
15 H. Michael Brucker Law Corporation
Steven M. Kipperman Law Corporation

16 /s/ _____
17 H. Michael Brucker Law Corporation
H. Michael Brucker

18 Counsel for Defendant
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November 15, 2013

Jeff Sedlik
c/o Art Center College of Design
1700 Lida Street
Pasadena, CA 91103

Re: Deposition of Jeff Sedlik; 11/5/2013
Karol Western Corp. v. Smith News Company, Inc.
Our file no. 365341

Dear Mr. Sedlik:

Request having been duly made, you are hereby notified pursuant to Federal Rules of Civil Procedure, Rule 30(e) that the original transcript of the testimony of your deposition is available for review during the next 30 days at our Los Angeles office, 1875 Century Park East, Suite 1300, Los Angeles, California, 90067, during our business hours. It is necessary that you call (310) 207-8000 for an appointment if you wish to come to our office.

If there are changes in form or substance, you have the right to sign a statement reciting such changes and the reasons for making them. We have appended a correction sheet to the transcript for this purpose.

Very truly yours,

A handwritten signature in cursive script that reads "Elena Brooks".

Elena Brooks,
Customer Service Manager

cc: Donald Brunsten, Esq.
H. Michael Brucker, Esq.
Bruce L. Ishimatsu, Esq.

1875 Century Park East

Suite 1300

Los Angeles, CA 90067

310.207.8000

Fax 310.207.8001

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January 3, 2014

H. Michael Brucker, Esq.
H. Michael Brucker, Attorney at Law
5855 Doyle Street
Emeryville, CA 94608

Re: Deposition of Jeff Sedlik; 11/05/2013
Karol Western Corp. v. Smith News Company, Inc.
Our file no. 365341

Dear Mr. Brucker:

40
YEARS

1875 Century Park East

Suite 1300

Los Angeles, CA 90067

310.207.8000

Fax 310.207.8001

San Francisco

Orange County

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barkley@barkley.com

www.barkley.com



Review of the transcript having been requested pursuant to Rule 30(e) and notification of availability having been provided by our office, please be informed that the deponent:

- ☐ Reviewed the transcript during the period allowed.
- ☒ Did not review the transcript during the period allowed.
- ☐ Signed a statement reciting changes and the reasons given for making them. Said statement is appended to the original transcript and a copy thereof is enclosed herewith.

Pursuant Rule 30(f)(1) the original deposition transcript has been sealed and is being sent to you herewith as the attorney who arranged for the transcript.

Very truly yours,


Chun Su,
Customer Service Department

Encl: Original Transcript

cc: Donald Brunsten, Esq.
Bruce L. Ishimatsu, Esq.

